

REMARKS

The present application was filed on December 29, 2000 with claims 1-29. Claims 1-3, 5-11, 13-18 and 20-31 are pending and claims 1, 8, 16 and 23 are the pending independent claims.

In the outstanding final Office Action dated January 13, 2005, the Examiner: (i) rejected claims 1, 16, 30 and 31 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,297,249 to Bernstein et al. (hereinafter "Bernstein"); (ii) rejected claims 8 and 23 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,029,245 to Scanlan (hereinafter "Scanlan"); (iii) rejected claims 2, 3, 5, 6, 17, 18, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Bernstein; (iv) rejected claims 7 and 22 under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of U.S. Patent No. 5,421,008 to Banning et al. (hereinafter "Banning"); (v) rejected claims 9-12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over Scanlan; (vi) rejected claims 13, 14, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Scanlan in view of Bernstein; and (vii) rejected claims 15 and 29 under 35 U.S.C. §103(a) as being unpatentable over Scanlan in view of Banning.

In response to the final Office Action, claims 1 and 16 have been amended to more clearly recite the present invention.

With regard to the rejection of claims 1, 16, 30 and 31 under 35 U.S.C. §102(b) as being anticipated by Bernstein, Applicant respectfully asserts that Bernstein fails to teach or suggest all of the limitations in claims 1, 16, 30 and 31, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicant asserts that the rejection based on Bernstein does not meet this basic legal requirement. Support for this assertion follows.

Independent claims 1 and 16 recite techniques for managing target documents referred to by referring documents. One or more referring documents are identified as having at least one hypertext link pointing to a target document in storage. It is determined when a hypertext link of the one or more referring documents ceases to exist, and when the one or more hypertext links pointing to the

target document cease to exist, the target document is enabled to be removed from storage. Support for the amendments to claims 1 and 16 can be found on pages 2, 3 and 11 of the specification.

The portion of Bernstein cited by the Examiner with regard to this rejection describes database maintenance and, more particularly, maintenance when a document, link marker or link is created, changed or deleted. If a document is to be deleted, the link markers in the document are identified and then removed in a looping process. The removal of link markers involves identifying and deleting links attached to the link marker and rewriting the other end link marker. When no link markers remain in the document, the document is deleted from the database.

Bernstein describes the identification and removal of hypertext links in a single document and the removal of that document which had the hypertext links. The documents of Bernstein having the hypertext links may be considered referring documents. Thus, Bernstein fails to disclose methods of managing target documents as recited in independent claims 1 and 16 of the present invention. Bernstein also fails to disclose the limitation of enabling the removal of a target document from the storage when the one or more hypertext links pointing to the target document cease to exist.

In the final Office Action, the Examiner contends that the elements of claims 1 and 16 are an intrinsic part of Bernstein. However, while there is no argument made in the final Office Action supporting inherency, according to the Federal Circuit, “[i]nherency does not embrace probabilities or possibilities.” Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1297, 63 USPQ2d 1597 (Fed. Cir. 2002). Further, an inherent anticipation requires that the missing descriptive material is necessarily present, and not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Thus, the alleged inherent feature must flow from the reference, and it is not sufficient to state that the alleged inherent feature could flow from the reference. Bernstein contains no disclosure of the management or removal of target documents, and fails to even suggest that these elements are possibly present. Thus, the missing descriptive material is not necessarily present and Bernstein does not disclose the material necessary to support a rejection based on inherency.

Dependent claims 30 and 31 are patentable at least by virtue of their dependency from independent claim 1, and also recite patentable subject matter in their own right. Accordingly,

withdrawal of the rejection to claims 1, 16, 30 and 31 under 35 U.S.C. §102(b) is therefore respectfully requested.

With regard to the rejection of claims 8 and 23 under 35 U.S.C. §102(a) as being anticipated by Scanlan, Applicant respectfully asserts that Scanlan fails to teach or suggest all of the limitations in claims 8 and 23, and the rejection does not meet the basic legal requirement for anticipation described above.

Independent claims 8 and 23 recite techniques for providing security for target documents referred to by referring documents. A first referring document having a hypertext link pointing to a target document stored in a storage is identified. The first referring document has a security access requirement which is applied to the target document.

The portion of Scanlan cited by the Examiner discloses dynamic assignment of security parameters to web pages. A security injection profile is provided for storing security parameters for each security protocol. When a browser enabled with a particular security protocol requests an HTML page in the secure set, the page is accessed from web server storage, security parameters of the protocol are accessed and injected into the access page, and the page is sent to the browser.

Scanlan describes the injection of security parameters into a web page from a web browser. Thus, although Scanlan describes use of a hyperlink to request an HTML page that requires security, it fails to disclose the application of a security access requirement from a first referring document to the target document to which the hypertext link points.

In the final Office Action, the Examiner contends that the traversal is invalid, however, Applicant maintains that accessing a page from web server storage and injecting security parameters into the page before sending it to a browser, as described in Scanlan, differs significantly from applying a security access requirement from a referring document to a target document pointed to by a hyperlink of the referring document. Accordingly, withdrawal of the rejection to claims 8 and 23 under 35 U.S.C. §102(a) is therefore respectfully requested.

With regard to the rejection of claims 2, 3, 5, 6, 17, 18, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Bernstein, Applicant asserts that such claims are patentable at least by virtue of their dependency from respective independent claims 1 and 16. Further, one or more of

dependent claims 2, 3, 5, 6, 17, 18, 20 and 21 contain patentable subject matter in their own right. For example, Bernstein fails to teach or suggest the steps of decrementing a counter of the target document when a hypertext link ceases to exist, and determining whether the count for the counter of the target document equals zero. Bernstein fails to teach or suggest any management of a target document.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277, F.3d 1338, 1343 (Fed. Cir. 2002). In the final Office Action the Examiner provides the following statements to prove obviousness: “it was notoriously well known in the art at the time of the invention that maintaining a count of a class of item helps to determine when that class of item has been entirely removed. It would have been obvious to one of ordinary skill in the art at the time of the invention to help determine when the references have been entirely removed.”

Applicant again submits that this statement is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record as support.

In response to these previously submitted arguments, the Examiner contends that “the use of a counter is common in computing, in such areas as printing, and is certainly not patentable material.” Applicant again submits that this statement is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. Further, the Examiner again fails to identify any objective evidence of record. Additionally, the counter recited in the claims relates to a target document and a hyperlink, and is not related in any way to a printer. Accordingly, withdrawal of the rejection to claims 2, 3, 5, 6, 17, 18, 20 and 21 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 7 and 22 under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of Banning, Applicant asserts that such claims are patentable at least by virtue of their dependency from independent claims 1 and 16, respectively. Further, one

or more of dependent claims 7 and 22 contain patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 7 and 22 under 35 U.S.C. §103(a) is therefore respectfully requested.

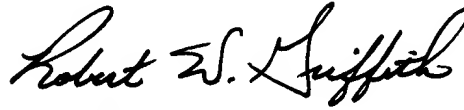
With regard to the rejection of claims 9-11 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over Scanlan, Applicant asserts that claims 9-11 and 24-26 are patentable at least by virtue of their dependency from independent claims 8 and 23, respectively. Further, one or more of dependent claims 9-11 and 24-26 contain patentable subject matter in their own right. For example, Scanlan fails to disclose the identification of a second referring document having a hypertext link pointing to the target document, the determination of whether the second referring document has the security access requirement, and the prevention of the second referring document from accessing the target document if the second referring document does not have the security access requirement. The final Office Action again makes statements based on subject belief and unknown authority in rejecting these claims which provides insufficient support for an obviousness rejection. Further, the Examiner again fails to identify any objective evidence of record as support. Accordingly, withdrawal of the rejection to claims 9-11 and 24-26 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 13, 14, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Scanlan in view of Bernstein, Applicant asserts that such claims are patentable at least by virtue of their dependency from independent claims 8 and 23, respectively. Further, one or more of dependent claims 13, 14, 27 and 28 contain patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 13, 14, 27 and 28 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 15 and 29 under 35 U.S.C. §103(a) as being unpatentable over Scanlan in view of Banning, Applicant asserts that such claims are patentable at least by virtue of their dependency from independent claims 8 and 23, respectively. Further, one or more of dependent claims 15 and 29 contain patentable subject matter in their own right. Accordingly, withdrawal of the rejection to claims 15 and 29 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicant believes that claims 1-3, 5-11, 13-18 and 20-31 are in condition for allowance, and respectfully requests withdrawal of the §102(b), §102(a) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, reading "Robert W. Griffith". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

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